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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/999,308	12/29/97	FUJINO	N FUJ014691

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NEW YORK NY 10118-0110

LM41/0330

EXAMINER

ENG, G

ART UNIT	PAPER NUMBER
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2743

4

DATE MAILED: 03/30/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/999,308

Applicant(s)  
Fujino et al.

Examiner  
George Eng

Group Art Unit  
2743

☒ Responsive to communication(s) filed on Dec 29, 1997

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Specification*

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Rejections - 35 U.S.C. § 112*

2. Claims 7-8 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 7, it is unclear what is meant by "said automatic data fetch means preliminarily fetches data obtainable while no data are received and stores the data in said storage means during the data communication, and accesses said data storage means during voice communication, thereby realizing virtual data communication during the voice communication".

Claim 8 is rejected because of depending on claim 7 containing the same deficiency.

Regarding claim 15, it is unclear how "steps (d) and (e) are followed when no data are received on the terminal side during the data communication between said terminal and said server; and said data stored in said step (e) is accessed during the voice communication, thereby establishing virtual data communication during the voice communication"

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*Claim Rejections - 35 U.S.C. § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldman et al. (US PAT. 4,995,074 hereinafter Goldman).

Regarding claim 1, Goldman discloses a communication system as shown in figure 1 comprising a server (i.e., a host computer 16), a terminal 14 for communicating data with the server, a communication network 12, and an interface (i.e., 28) for disconnecting a line being used for data communication without issuing any disconnection notifications of the terminal when a third party other than the server is being voice communicated during a data communication between the terminal and the server (col. 4 lines 31-61 and col. 5 lines 4-11).

Regarding claim 2, it is inherently of obtaining a telephone number of the third party in order to communicate.

Regarding claims 3-4, Goldman teaches the server comprising a telephone switch means and an interface (i.e., 34) for temporarily disconnecting a line between the server and the terminal when a voice communication to the third party is issued (col. 4 line 62 through col. 5 line 11).

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Regarding claim 5, Goldman teaches the line interface providing on a terminal side for disconnecting the line when a request for voice communication with the third party (col. 4 lines 31-61).

Regarding claim 6, Goldman teaches the interface comprising a first means for managing communication status (col. 5 line 49 through col. 6 line 2).

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claims 11-12, the limitations of the claims are rejected as the same reasons set forth in claims 3-4.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 6.

***Claim Rejections - 35 U.S.C. § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 7-8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman et al. (US PAT. 4,995,074 hereinafter Goldman) in view of Iizuka et al. (US PAT. 5,699,521 hereinafter Iizuka).

Regarding claims 7-8, Goldman differs from the claimed invention in not specifically teaches the communication system further comprising data fetch means for fetching data from the server to the terminal and storage means for storing data fetched by the data fetch means. However, Iizuka teaches such (figure 1 and col. 6 lines 2-42). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Goldman in having data fetch means for fetching data from the server to the terminal and storage means for storing data fetched by the data fetch means, as per teaching of Iizuka, because of

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avoiding congestion of the communication network due to unnecessary re-sending process and disconnection of the logic line.

Regarding claim 15, the limitations of the claim are rejected as the same reasons set forth in claims 8-9.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Carter et al. (US PAT. 4,596,021) discloses a modem for switching between voice and data communication on a single telephone line (abstract and figure 1). Gregorek et al. (US PAT. 5,557,658) discloses a communication marketing system plays announcement to the party placed on hold by the called station until the called station signals the network to reconnect the called station to the party on hold (abstract). Smith et al. (US PAT. 5,841,840) discloses a multiple line modem and method for providing voice on demand (figures 4A-4B and col. 4 line 29 through col. 5 line 25). Norris et al. (US PAT. 5,805,587) discloses a facility to alert a subscriber whose telephone set is connected to the Internet of a call waiting via the Internet connection (abstract).

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 305-9508 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

GEORGE ENG

March 24, 1999

  
CURTIS A. KUNTZ  
SUPERVISORY PATENT EXAMINER  
GROUP 2700